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12/11/03

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No: 09/775,425 Examiner: R. Stormer  
Appellant: Lee A. Chase Group Art Unit: 3617  
Filing Date: February 1, 2001  
Title: Vehicle Wheel and Overlay Assembly  
Docket No.: LII153B US

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REPLY BRIEF TO EXAMINER'S ANSWER UNDER 37 CFR  
§1.193(b)(1)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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Sir:

Pursuant to the provisions of MPEP §1208, (A)(10) the Examiner is required to  
set forth...

"For each ground of rejection applicable to the  
appeal claims, an explanation of the ground of rejection, or  
reference to a final rejection or other single prior action for  
a clear exposition of the rejection. ...

(c) For each rejection under 35 U.S.C. §102, the  
Examiner's answer, or single prior action, shall explain  
why the rejected claims are anticipated or not patentable  
under 35 U.S.C. §102, pointing out where all of the specific  
limitations recited in the rejected claims are found in the  
prior art relied upon in the rejection.

(d) For each rejection under 35 U.S.C. §103, the Examiner's answer, or single prior action, shall:

(i) state the ground of rejection and point out where each of the specific limitations recited in the rejection claims is found in the prior art relied on in the rejection,

(ii) identify any difference between the rejected claims and the prior art relied on, and

(iii) explain how and why the claimed subject matter is rendered unpatentable over the prior art. If the rejection is based upon a combination of references, the Examiner's answer, or single prior action, shall explain the rationale for making the combination.

(e) For each rejection under 35 U.S.C. §102 or §103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the Examiner complies with requirements of paragraphs (c) and (d) of this section, the Examiner shall compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate."

The above quoted section of the MPEP makes it extremely clear what the Examiner's requirement and burden is in the answer to Appellant's brief.

After carefully reviewing the Examiner's answer, it is amply clear, that the Examiner has completely failed to follow the requirements of MPEP §1208 as well as failed to meet the burden placed upon him by completely neglecting the disclosure of the prior art and clearly pointing out where any of the prior art disclose Appellant's independent claim structure wherein an overlay has an outer peripheral lip or diameter that is aligned **within a predetermined margin** of the radially outermost edge of the wheel such that the outer diameter of the overlay cannot extend radially beyond the edge

of the outer diameter of a wheel, regardless of tolerance variations between the overlay and the wheel. The Examiner also completely failed to understand Appellant's arguments with regard to the references, that is, the disclosure of the references completely lack enablement with regard to an overlay not extending beyond the outer diameter of the rim flange of the wheel and therefore cannot anticipate Appellant's independent claims which require an overlay that has a peripheral lip with "...a radially outermost edge aligned **within a predetermined margin** of said radially outermost edge of said lip flange of said wheel such that said peripheral lip of said overlay cannot extend radially beyond the outermost edge of the flange lip of the wheel regardless of tolerance variations of said overlay of said wheel". (emphasis added)

On page 4 of the Examiner's answer, in paragraph 11, subheading Response to Arguments, the Examiner misstates Appellant's argument by failing to point out to the board that the independent claims are directed to a wheel and overlay assembly in which the overlay has an outer peripheral lip or diameter that is aligned **within a predetermined margin** of the radially outermost edge of the lip flange of the wheel rim such that the lip of the overlay cannot extend radially beyond the edge of rim regardless of the tolerance variations. It is important to point out that the Examiner failed to recognize the importance of the words... within a predetermined margin... since he did not disclose this language as being an important portion of Appellant's claims. Instead, the Examiner artificially creates an issue, not part of the issues set forth in paragraph six of the brief, obviously for the very reason that he cannot point to prior art disclosure

wherein each and every element of the claimed invention is arranged as in the claims to attempt to support a 102 rejection as required by law.

From the statement in Appellant's brief that the disclosure in the references lack enablement with regard to the overlay not extending beyond the outside diameter of the rim flange of the wheel, the Examiner creates an artificial issue by the following statements found on page five:

“Appellant's statement, taken further, is to argue that of the prior art references used in the rejection, the wheel covers or overlays **can** possibly extend beyond the outer edge of the rim flange even though such is not shown or disclosed because of tolerance variations in the rim flange or the overlay.”

The Examiner then goes on to spend three pages explaining why he does not agree with his own fabricated issue and again, completely fails to meet his burden by setting forth disclosure in the prior art references that anticipate the Appellant's claims. Instead the Examiner addresses this artificial issue by pointing out that the Appellant is incorrect by reading subject matter into these references that is not shown in the drawings that are disclosed in the specification. Clearly, this is completely contrary to the requirements of the Examiner's answer when viewing MPEP §1208. Accordingly, the Appellant specifically requests that this honorable Board completely neglect this artificial issue presented by the Examiner since it is not part of the issues required to be decided according to the file wrapper record in this appeal.

Also, it is not well taken that the Examiner takes liberty with using words that are not found in the references. For example, on page six of the Examiner's answer, the Examiner specifically recites the teachings of Beam as:

“An overlay for a wheel comprising an outer edge 48 of the overlay which must be forcibly urged past the lip 46 of the rim flange (lines 58-67 of column 5 of Beam) in a snap fit so that the overlay will be prevented from removal by the lip 46.”

The undersigned has carefully reviewed Beam and the words “past” as well as “snap” do not appear anywhere in the complete disclosure of Beam. Accordingly, it is not well taken that the Examiner uses specific language, which nowhere appears in the reference and alleges that this disclosure is present in this reference.

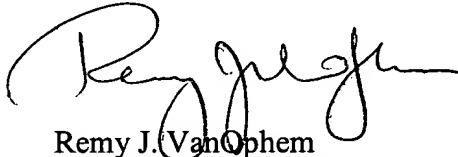
In any event, in support of this appeal, the Appellant wishes to incorporate herein by reference the entire argument section of the brief for the reasons that it clearly sets forth that the Appellant's claims as currently pending in the brief are patentably distinct from any of the references cited by the Examiner in the 35 U.S.C. §102 or §103 rejections.

Further, it is respectfully requested, that the Examiner's answer be considered nonresponsive in view of the requirement of MPEP §1208 and that none of the argument be entered as matter of record for the reasons that the complete answer is based on a issue that is not set forth in the issues identified in the brief and acknowledged by both the Appellant and the Examiner.

In conclusion, for the reasons set forth above, it is respectfully submitted that each of Claims 1-6, 8-11, 13-20, 22-25, 27 and 28 is patentable in scope over the prior art references relied on in support of the Examiner's final rejection. Further, the rejections of such claims are improper as a matter of law and reversal of the final rejections of the claims appealed is therefore respectfully requested.

Respectfully submitted,

VANOPHEM & VANOPHEM



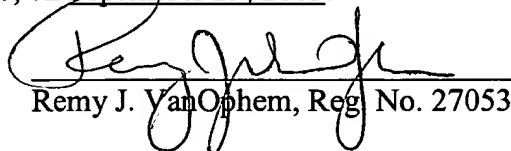
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Certificate under 37 CFR §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on September 29, 2003.

Date: September 29, 2003

  
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